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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,158	11/15/2001	Jeffrey D. Kenyon	020366-086100US	3861

20350 7590 09/07/2007
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EXAMINER

POND, ROBERT M

ART UNIT	PAPER NUMBER
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3625

MAIL DATE	DELIVERY MODE
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09/07/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/991,158

Applicant(s)

KENYON, JEFFREY D.

Examiner

Robert M. Pond

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2, 4, 6, 7, 23, 25 and 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2, 4, 6, 7, 23, 25 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

All pending claims (2, 4, 6, 7, 23, 25, and 26) were examined in this non-final office action necessitated by new grounds of rejection.

Response to Arguments

Applicant's arguments, see Remarks, filed 29 June 2007, with respect to the rejection(s) of claim(s) 2, 4, 6, 7, 23, 25, and 26 under 35 USC 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of JunglePort in view of Yellowpages.com. Applicant's arguments are rendered moot.

Yellowpages.com (PTO-892, Item: U) is being entered as evidence depicting branding information (e.g. logo) being associated with every web page that could be satisfactorily reproduced using the Internet Archive Wayback Machine for www.yellowpages.com. Yellowpages.com provided further evidence of a self-sustaining website complete with branded content by the website owner and its advertisers.

The Applicant is reminded that twice-rejected claims are eligible for appeal.

Official Notice- admitted prior art

If applicant does not seasonably traverse the well-known statement, or official notice, during examination, then the object of the well-known statement is admitted as prior art. In re Chevenard, 139 F.2d 71, 60 USPQ 239 (CCPA 1943). A seasonable challenge constitutes a demand for evidence made as soon as practicable during prosecution. Thus, applicant is charged with rebutting the well-known statement in the next reply after the Office action in which the well-known statement was made.

To adequately traverse an official notice, an applicant must specifically point out the supposed errors in the examiner's action, stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.11 I(b). See also Chevenard, 139 F.2d at 713, 60 USPQ at 241. A general allegation that the claims define a patentable invention without any reference to the examiner's assertion of official notice is inadequate. [MPEP 2144.03(c)].

As in this case, where the applicant has not traversed the examiner's assertion of official notice, the statement is taken to be admitted prior art.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

- 1. Claims 2, 4, 23, 25, and 26 are rejected under 35 USC 103(a) as being unpatentable over JunglePort (a collection of prior art describing JunglePort services cited in Paper #20070413, PTO-892, Items: U-W) in view of Yellowpages.com (PTO-892, Item: U).**

JunglePort teaches the JunglePort web site service providing Palm mobile device users with access to content via their personal computers (U: see page 1; V: see page 1). JunglePort further teaches:

- accessing the information items at an on-line directory website, including providing the computer with a browser for navigating the Internet in order to use the website, using the computer to search a database at the website for a set of information items based on a search request from the user, displaying information items from the website on the computer, wherein the website provides on-line yellow pages directory listings, and the information items are part of those listings, and selecting additional information associated with one or more of the directory listings to accompany the directory listings wherein the directory listings include a business name, and wherein the additional information comprises one or*

more of driving directions, maps, advertisement, menu, coupons and a list of items for sale at the business;

placing the information items in an information shopping cart at the

website in response to selection of the information items by the user;

transmitting the information shopping cart having the selected information

items from the website to the portable device when the portable device

has direct communications link to the computer at the first location;

The following teachings address the claim element listed above:

JunglePort teaches providing Palm users with downloadable, customized city guides (i.e. Safaris) containing restaurant information, Yellow Pages listings, and vector-based maps for 39 US cities (U: see page 1).

JunglePort serves as the control center where users can select a specific geographical area, tune the JunglePort map to include a neighborhood, then add personalized restaurant content and Yellow Pages content based on cuisine and category choices. User preferences and settings are stored on the JunglePort server for future reference. Once content has been selected, the Safari is then downloaded to the handheld device (U: see page 2). JunglePort further teaches the user creating personalized JunglePort Safaris- or guides- at the desktop portal, and then downloading them (i.e. Safaris) to the Palm device (V: see page 2). Please note: the Palm device is directly connected to the user's computer via wired or wireless connection to perform synchronization.

- using the portable device to access the selected information items at the portable device when the portable device is at one of the second, remote locations away from the computer and without access to the directory website; as noted above, a Palm device is a mobile handheld computer usable in locations remote from the user's desktop computer. JunglePort content downloaded into the Palm is usable when disconnected from the user's desktop computer (U: see pages 1 and 2).
- and automatically placing branding information in the information shopping cart with the information items so that the branding information is displayed at the portable device with the information items, an advertiser's marketing message is extended to mobile device users via the advertiser's banner (i.e. branding information) ad that appears on the user's mobile device (W: see page 2).

JunglePort teaches all the above as noted under the 103(a) rejection and teaches and suggests i) downloading yellow pages listings to a user's portable self-contained computing device from a website, ii) automatically placing advertising information supplied by JunglePort advertisers into the user's Safari(s) (i.e. information shopping cart located in the user's portable device), and further teaches branding its online website service with the JunglePort logo (see JunglePort, Item: W). Although JunglePort does not mention identifying the owner of the website service at the user's portable device, it would have been obvious to one of ordinary skill in the art at time the invention was made for

JunglePort to brand its own content that is downloaded to the user's portable device in order to identify to the user the source of the content service as it does with its online website. The claim would have been obvious because a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the method is not of innovation but of ordinary skill and common sense.

JunglePort teaches all the above as noted under the 103(a) rejection and teaches and suggests i) branding its content downloaded to a user's portable device, ii) the branded content including a yellow pages listing, and iii) the yellow pages listing providing shopping, entertainment, and other categories of online content (see JunglePort, Item U: page 2). Although JunglePort does not mention competing websites serving branded yellow pages listings to a user's portable device, JunglePort in combination with Yellowpages.com teach and suggest the claimed invention. Yellowpages.com teaches a yellow pages directory service website, complete with branding indicia (i.e. Yellowpages.com logo) displayed at the top of every web page (U: see all pages). Yellowpages.com teaches serving as a user's online yellow pages directory for finding businesses and products quickly (U: page 2) and further teaches providing shopping content and other services. It would have been obvious to one of ordinary skill in the art at time the invention was made to adapt a content website such as Yellowpages.com to implement the methods as taught and suggested by JunglePort in order to expand content delivery to portable device users. Known work in one field of

endeavor may prompt variations of it for use in either the same field or a different field based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art.

- 2. Claim 6 is rejected under 35 USC 103(a) as being unpatentable over JunglePort (a collection of prior art describing JunglePort services cited in PTO-892, Items: U-W) and Yellowpages.com (PTO-892, Item: U) as applied to claim 2, further in view of Official Notice (admitted prior art cited in Paper #20070413 regarding notoriously old and well-known in the arts)**

JunglePort and Yellowpages.com teach all the above as noted under the 103(a) rejection and teach creating an information shopping cart (i.e. a Safari) to store content and serving Yellow Pages listings to a user's portable device, but do not mention the user naming their Safari. The Examiner takes the position that it was notoriously old and well-known in the arts at time the invention was made for computer users to be able to name a file or a folder containing data, content, or other information in order to provide user friendly or user recognizable content folder as a convenience. For example, Mac OS or Windows environments allowed users to name content folders. Therefore it would have been obvious to one of ordinary skill in the art at time the invention was made to modify the method of JunglePort and Yellowpages.com to allow users to name their content folders as taught by Official Notice, in order to provide a user convenience when using their Safari.

- 3. Claim 7 is rejected under 35 USC 103(a) as being unpatentable over JunglePort (a collection of prior art describing JunglePort services cited in PTO-892, Items: U-W) and Yellowpages.com (PTO-892, Item: U) and applied to claim 2, further in view of Beard (Paper #20070413, PTO-892, Item: X).**

JunglePort and Yellowpages.com teach all the above as noted under the 103(a) rejection and teach i) consumers using their Palm mobile devices to access content transferred from the JunglePort web site into the Palm mobile device, and ii) the downloaded Safari(s) being usable by the Palm device, but do not disclose a file format selected by the user. On the other hand, Beard teaches 24 uses of the Palm device and further teaches converting Word, WordPerfect, Excel, Lotus 1-2-3, text, and various MacIntosh formats for the Palm device (X: see at least pages 1 and 2). Therefore it would have been obvious to one of ordinary skill in the art at time the invention was made to modify the method of JunglePort and Yellowpages.com to convert user selected formats for the Palm device as taught by Beard, in order to accommodate a variety of applications, and thereby increase the utility of the Palm device.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Pond whose telephone number is 571-272-6760. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Robert M. Pond
Primary Examiner
August 23, 2007